

**REMARKS**

In the Office Action, the following actions were taken:

- a) Claims 1-6, 8-14, 16-24, and 44<sup>1</sup> were rejected under 35 U.S.C. § 101;
- b) Claims 1, 10-12, 14, 16, 17, 21, 25, 26, 33, 40, 44, 46, and 47<sup>2</sup> were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0018969 of Humpleman et al. ("Humpleman") in view of Las Vegas, Nevada, Hosts Infomercial Awards Conference, October 2, 2000, by Mark Albright, Knight-Ridder/Tribune Business News, pages 1-4 ("Albright"), in view of U.S. Patent Application Publication No. 2004/0243478 of Walker et al. ("Walker '478"), and further in view of U.S. Patent No. 6,216,111 to Walker et al. ("Walker '111");
- c) Claims 2-6, 18, 27, 34-38, and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman in view of Albright in view of Walker '478, and further in view of Walker '111, and further in view of Skin Care and Acne Treatment Products from Proactiv Solution Infomercial by Guthy-Renker ("Guthy-Renker");
- d) Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, in view of U.S. Patent No. 6,915,271 to Meyer et al. ("Meyer"), and further in view of Total Gym Infomercial by Engineering Fitness International, Inc. (1996-2001) ("EFI");

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<sup>1</sup> The Office Action, on page 2, indicates that claims 1-14, 16-24, and 44 were rejected under 35 U.S.C. §101. Claim 7, however, was canceled previously, without prejudice or disclaimer. Applicants respectfully request correction.

<sup>2</sup> The Office Action, on page 4, indicates that claims 1, 10, 11, 14, 16, 17, 21, 25, 26, 33, 40, 42-44, 46, and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman in view of Albright, in view of Walker '478, and further in view of Walker '111. The Office Action, on page 7, however, provides an alleged basis for rejecting claim 12 under 35 U.S.C. § 103(a) based on Humpleman, Albright, Walker '478, and Walker '111. In addition, claims 42 and 43 were previously canceled, without prejudice or disclaimer. Applicants respectfully request correction so that Applicants can provide a complete response to the Office Action.

- e) Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, in view of Meyer, in view of EFI, and further in view of the Examiner's Official Notice;
- f) Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman in view of Albright, in view of Walker '478, in view of Walker '111, and further in view of U.S. Patent No. 6,735,572 to Landesmann ("Landesmann");
- g) Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman in view of Albright, in view of Walker '478, and in view of Walker '111, and in view of Guthy-Renker, and further in view of U.S. Patent No. 5,335,679 to Baxter ("Baxter");
- h) Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman in view of Albright, in view of Walker '478, in view of Walker '111, in view of Guthy-Renker, in view of Baxter, and further in view of U.S. Patent No. 6,770,103 to Patel et al. ("Patel");
- i) Claims 22, 24, and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman in view of Albright, and in view of Walker '478, in view of Walker '111, and further in view of U.S. Patent No. 6,443,840 to Von Kohorn ("Von Kohorn");
- j) Claims 23 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman in view of Albright, in view of Walker '478, in view of Walker '111, and further in view of U.S. Patent No. 7,006,983 to Packes, Jr. et al. ("Packes"); and
- k) The rejection of claims 25-27 and 33-43 under 35 U.S.C. § 101 was withdrawn.

By this reply, Applicants have amended claims 1 and 33. Claims 1-6, 8-14, 16-38, 40, 41, and 44-48 are currently pending, with claims 1 and 33 being independent. Claims 7, 15, 39, 42, and 43 were canceled in previous amendments, without prejudice or disclaimer. Claims 28-32 have been withdrawn from consideration

as being non-elected. Based on the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejections.

**A. The § 101 Rejection of Claims 1-6, 8-14, 16-24, and 44**

Claims 1-6, 8-14, 16-24, and 44 and were rejected under 35 U.S.C. § 101 because the claimed invention is purportedly directed to non-statutory subject matter. Although Applicants respectfully disagree, Applicants, in an effort to advance prosecution, have amended claim 1. In a recent Federal Circuit decision, the court stated that “an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.” *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (en banc). Amended independent claim 1 recites, among other things, “. . . selecting, using a processor of a computer system, an item suited for the consumer having the obtained personal information.” Applicants submit that amended independent claim 1 is tied to a particular machine, and thus conforms with the Federal Circuit decision in *In re Bilski*. Claims 2-6, 8-14, 16-24, and 44 depend from amended independent claim 1. Claims 2-6, 8-14, 16-24, and 44 are therefore also directed to statutory subject matter.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection of claims 1-6, 8-14, 16-24, and 44.

**B. The § 103(a) Rejection of Claims 1, 10-12, 14, 16, 17, 21, 25, 26, 33, 40, 44, 46, and 47 Based on Humpleman, Albright, Walker ‘478, and Walker ‘111**

Applicants respectfully traverse the § 103(a) rejection of claims 1, 10-12, 14, 16, 17, 21, 25, 26, 33, 40, 44, 46, and 47 under 35 U.S.C. § 103(a) as being unpatentable

over Humpleman in view of Albright, in view of Walker '478, and further in view of Walker '111. A *prima facie* case of obviousness has not been established with respect to claims 1, 10-12, 14, 16, 17, 21, 25, 26, 33, 40, 44, 46, and 47.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

**1. Claim 1**

Amended independent claim 1 recites, among other things, “based on the obtained personal information, selecting . . . an item suited for the consumer having the obtained personal information,” and “customizing the incentive such that the incentive relates to purchase of the selected item.” The cited references fail to teach or suggest the recited subject matter.

The Office Action correctly observes that Humpleman does not disclose “obtaining personal information from the consumers; and customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information.” Office Action at 6. The Office Action, however, attempts to cure the deficiencies of Humpleman by relying on Walker ‘111. Id. The Office Action asserts that Walker ‘111 discloses the recited subject matter. Id. (Citing Walker ‘111, col. 3, lines 42-57.) Applicants disagree.

Walker ‘111 discloses “a system . . . whereby a telemarketer may reward a customer during the telemarketing call, thereby providing customer with *an incentive to listen to the telephone sales presentation*.” Walker ‘111, Abstract (emphasis added). The system of Walker ‘111 purportedly provides “better targeting and attraction of qualified customers, more flexible and effective tailoring of both the presentation and rewards to the interests of the customer, the ability to provide immediate rewards and hence gratification to the customer, [and] the ability to solicit real-time feedback from the customer indicating that he is listening to the information.” Id. at col. 3, lines 47-52.

Nowhere does Walker '111, however, disclose “based on the obtained personal information, selecting . . . an item suited for the consumer having the obtained personal information,” as recited in amended independent claim 1. Instead, the system of Walker '111 concerns rewards to incentivize a customer to listen to a telephone sales presentation. Walker '111, Abstract. Thus, Walker '111 does not provide any teaching or suggestion of “customizing [an] incentive such that the incentive relates to purchase of [a] selected item [suited for a customer having obtained personal information],” as recited in amended independent claim 1.

Neither Albright nor Walker '478 cures these deficiencies of Humpleman, and the Office Action does not allege otherwise. Office Action at 5-6.

In view of the above-noted deficiencies of the cited references, and the lack of any legitimate reason for one of ordinary skill in the art to modify the teachings of the references to achieve the claimed combination, there is no *prima facie* case of obviousness with respect to claim 1. Accordingly, the rejection of amended independent claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

## **2. Claim 33**

Amended independent claim 33, although of different scope, recites features that are similar to the features recited in amended independent claim 1. For example, amended independent claim 33 recites, among other things, “a selection component for, based on the obtained personal information, selecting an item suited for the consumer having the obtained personal information,” and “an incentive component for customizing the incentive such that the incentive relates to purchase of the selected item.”

As explained above with respect to amended independent claim 1, Humpleman, Albright, Walker '478, and Walker '111, taken alone or in combination, fail to teach or suggest “based on the obtained personal information, selecting . . . an item suited for the consumer having the obtained personal information,” and “customizing the incentive such that the incentive relates to purchase of the selected item,” as recited in amended independent claim 1.

For at least reasons similar to the reasons set forth with respect to amended independent claim 1, a *prima facie* case of obviousness has not been established with respect to amended independent claim 33. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of amended independent claim 33 based on Humpleman, Albright, Walker '478, and Walker '111.

**3. Claims 10-12, 14, 16, 17, 21, 25, 26, 40, 44, 46, and 47**

Claims 10-12, 14, 16, 17, 21, 25, 26, and 44 depend from amended independent claim 1, and claims 40, 46, and 47 depend from amended independent claim 33. Thus, the dependent claims are allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 10-12, 14, 16, 17, 21, 25, 26, 40, 44, 46, and 47 based on Humpleman, Albright, Walker '478, and Walker '111.

Furthermore, the dependent claims recite further distinctions over the cited references. For example, claim 12 recites, among other things, that “further information includes individualized advice related to the mass consumer product and based on the

obtained personal information.” The cited references fail to teach or suggest the recited subject matter. The Office Action asserts that Walker ‘111 discloses that “the further information includes individualized advice related to the mass consumer product and based on personal information.” Office Action at 7 (citing Walker ‘111, col. 3, lines 42-55). This is incorrect.

As explained above with respect to amended independent claim 1, the system of Walker ‘111 relates to rewards to incentivize a customer to listen to a telephone sales presentation. Walker ‘111, Abstract. In order to reward the appropriate customer, the system of Walker ‘111 provides “ability to solicit real-time feedback from the customer indicating that he is listening to the information.” Walker ‘111, col. 3, lines 51-52. “Feedback from the customer can be required, thereby confirming ongoing attention to the information being provided. Walker ‘111, col. 9, lines 8-10. Nowhere does Walker ‘111, however, disclose or suggest that “further information includes individualized advice related to the mass consumer product and based on the obtained personal information,” as recited in claim 12.

For these additional reasons, the § 103(a) rejection of claims 10-12, 14, 16, 17, 21, 25, 26, 40, 44, 46, and 47 based on Humpleman, Albright, Walker ‘478, and Walker ‘111 should be withdrawn.

**C. The § 103(a) Rejection of Claims 2-6, 18, 27, 34-38, and 41 Based on Humpleman, Albright, Walker ‘478, Walker ‘111, and Guthy-Renker**

Claims 2-6, 18, and 27 depend from amended independent claim 1, and claims 34-38 and 41 depend from amended independent claim 33. As explained above with respect to amended independent claims 1 and 33, Humpleman, Albright,



Walker '478, and Walker '111, taken alone or in combination, fail to teach or suggest “based on the obtained personal information, selecting . . . an item suited for the consumer having the obtained personal information,” and “customizing the incentive such that the incentive relates to purchase of the selected item,” as recited in amended independent claim 1, and similarly in amended independent claim 33.

Guthy-Renker fails to cure these deficiencies of Humpleman, Albright, Walker '478, and Walker '111, and the Office Action does not allege otherwise as Guthy-Renker is relied upon only for its alleged teachings related to demonstrating a product during broadcasting of a program and alleged teachings that the product is at least one of a personal care product and a cosmetic product. Office Action at 14-22. For at least these reasons, the cited references do not support the § 103(a) rejection of claims 2-6, 18, 27, 34-38, and 41. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 2-6, 18, 27, 34-38, and 41 based on Humpleman, Albright, Walker '478, Walker '111, and Guthy-Renker.

**D. The § 103(a) Rejection of Claim 8 Based on Humpleman, Albright, Meyer, and EFI**

Claim 8 depends from amended independent claim 1. As explained above with respect to amended independent claim 1, Humpleman, Albright, Walker '478, and Walker '111, taken alone or in combination, fail to teach or suggest “based on the obtained personal information, selecting . . . an item suited for the consumer having the obtained personal information,” and “customizing the incentive such that the incentive relates to purchase of the selected item,” as recited in amended independent claim 1.

Meyer fails to cure these deficiencies of Humpleman, Albright, Walker '478, and Walker '111, and the Office Action does not allege otherwise or set forth any explanation of alleged teachings of Meyer. Office Action at 22-23.

EFI fails to cure these deficiencies of Humpleman, Albright, Walker '478, Walker '111, and Meyer, and the Office Action does not allege otherwise as EFI is relied upon only for its alleged teachings of having contact information for consumers to use to request an incentive. Id. For at least these reasons, the cited references do not support the § 103(a) rejection of claim 8. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 8 based on Humpleman, Albright, Meyer, and EFI.

**E. The § 103(a) Rejection of Claim 9 Based on Humpleman, Albright, Meyer, EFI, and the Examiner's Official Notice**

Claim 9 depends from claim 1. As explained above with respect to claim 1, Humpleman, Albright, Walker '478, and Walker '111, taken alone or in combination, fail to teach or suggest “based on the obtained personal information, selecting . . . an item suited for the consumer having the obtained personal information,” and “customizing the incentive such that the incentive relates to purchase of the selected item,” as recited in amended independent claim 1. As explained above with respect to claim 8, EFI fails to cure the deficiencies of Humpleman, Albright, and Meyer.

The Examiner's Official Notice, which Applicants respectfully dispute, fails to cure these deficiencies of Humpleman, Albright, Meyer, and EFI, as the Examiner's Official Notice merely alleges that “it is [purportedly] old and well known in the art to provide contact information consumers several times during a television program or infomercial

of incentives.” Office Action at 23-24. For at least these reasons, the cited references and the Examiner’s Official Notice do not support the § 103(a) rejection of claim 9. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 9 based on Humpleman, Albright, Meyer, EFI, and the Examiner’s Official Notice.

**F. The § 103(a) Rejection of Claim 13 Based on Humpleman, Albright, Walker ‘478, Walker ‘111, and Landesmann**

Claim 13 depends from amended independent claim 1. As explained above with respect to amended independent claim 1, Humpleman, Albright, Walker ‘478, and Walker ‘111, taken alone or in combination, fail to teach or suggest “based on the obtained personal information, selecting . . . an item suited for the consumer having the obtained personal information,” and “customizing the incentive such that the incentive relates to purchase of the selected item,” as recited in amended independent claim 1.

Landesmann fails to cure the deficiencies of Humpleman, Albright, Walker ‘478, and Walker ‘111, and the Office Action does not allege otherwise as Landesmann is relied upon only for its alleged teachings of “buyer-driven targeting of purchasing entities having information that includes a list of retail establishments that carry the product and are in geographical proximity to respective locations of the consumers.” Office Action at 24. For at least these reasons, the cited references do not support the § 103(a) rejection of claim 13. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 13 based on Humpleman, Albright, Walker ‘478, Walker ‘111, and Landesmann.

**G. The § 103(a) Rejection of Claim 19 Based on Humpleman, Albright, Walker '478, Walker '111, Guthy-Renker, and Baxter**

Claim 19 depends from claim 18, which depends from amended independent claim 1. As explained above with respect to claim 18, Humpleman, Albright, Walker '478, Walker '111, and Guthy-Renker, taken alone or in combination, fail to teach or suggest “based on the obtained personal information, selecting . . . an item suited for the consumer having the obtained personal information,” and “customizing the incentive such that the incentive relates to purchase of the selected item,” as recited in amended independent claim 1.

Baxter fails to cure these deficiencies of Humpleman, Albright, Walker '478, Walker '111, and Guthy-Renker, and the Office Action does not allege otherwise as Baxter is relied upon only for its alleged teachings of “a device and process for use in coloring hair having a hair coloring kit for performing a multi-step hair coloring process.” Office Action at 25. For at least these reasons, the cited references do not support the § 103(a) rejection of claim 19. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 19 based on Humpleman, Albright, Walker '478, Walker '111, Guthy-Renker, and Baxter.

**H. The § 103(a) Rejection of Claim 20 Based on Humpleman, Albright, Walker '478, Walker '111, Guthy-Renker, Baxter, and Patel**

Claim 20 depends from dependent claim 19, which depends from claim 1. As explained above with respect to claim 19, Humpleman, Albright, Walker '478, Walker '111, Guthy-Renker, and Baxter, taken alone or in combination, fail to teach or suggest “based on the obtained personal information, selecting . . . an item suited for

the consumer having the obtained personal information,” and “customizing the incentive such that the incentive relates to purchase of the selected item,” as recited in amended independent claim 1.

Patel fails to cure these deficiencies of Humpleman, Albright, Walker '478, Walker '111, Guthy-Renker, and Baxter, and the Office Action does not allege otherwise as Patel is relied upon only for its alleged teachings of “a method and composition for the gradual permanent coloring of hair compris[ing] a hair coloring kit for performing a multi-step hair coloring process[,] the multi-step hair coloring process compris[ing] applying highlighting material to moist hair and the demonstrating includ[ing] demonstrating the applying of the highlight material to moist hair.” Office Action at 26. For at least these reasons, the cited references do not support the § 103(a) rejection of claim 20. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 20 based on Humpleman, Albright, Walker '478, Walker '111, Guthy-Renker, Baxter, and Patel.

**I. The § 103(a) Rejection of Claims 22, 24, and 48 Based on Humpleman, Albright, Walker '478, Walker '111, and Von Kohorn**

Claims 22 and 24 depend from amended independent claim 1, and claim 48 depends from claim 33. As explained above with respect to amended independent claim 1, Humpleman, Albright, Walker '478, and Walker '111, taken alone or in combination, fail to teach or suggest “based on the obtained personal information, selecting . . . an item suited for the consumer having the obtained personal information,” and “customizing the incentive such that the incentive relates to purchase of the selected item,” as recited in amended independent claim 1 and similarly in claim 33.

Von Kohorn fails to cure these deficiencies of Humpleman, Albright, Walker '478, and Walker '111, and the Office Action does not allege otherwise as Von Kohorn is relied upon only for its alleged teachings of "evaluation of responses of participatory broadcast audience with prediction of winning contestants; monitoring, checking and controlling of wagering, and automatic crediting and couponing." Office Action at 27-29. For at least these reasons, the cited references do not support the § 103(a) rejection of claims 22, 24, and 48. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 22, 24, and 48 based on Humpleman, Albright, Walker '478, Walker '111, and Von Kohorn.

**J. The § 103(a) Rejection of Claims 23 and 25 Based on Humpleman, Albright, Walker '478, Walker '111, and Packes**

Claims 23 and 25 depend from amended independent claim 1. As explained above with respect to amended independent claim 1, Humpleman, Albright, Walker '478, and Walker '111, taken alone or in combination, fail to teach or suggest "based on the obtained personal information, selecting . . . an item suited for the consumer having the obtained personal information," and "customizing the incentive such that the incentive relates to purchase of the selected item," as recited in amended independent claim 1.

Packes fails to cure the deficiencies of Humpleman, Albright, Walker '478, and Walker '111, and the Office Action does not allege otherwise as Packes is relied upon only for its alleged teachings of "a method and system for processing a mail-in-rebate certificate" and "restricting the incentive such that the incentive can only be redeemed at a retail establishment at the time of obtaining the product." Office Action at 30-31. For

at least these reasons, the cited references do not support the § 103(a) rejection of claims 23 and 25. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 23 and 25 based on Humpleman, Albright, Walker '478, Walker '111, and Packes.

**K. Conclusion**


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: August 14, 2009

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